

REMARKS

Election/Restriction

The Office Action asserts that the application contains claims directed to the following allegedly patentably distinct species:

Species A: Represented by Figure 2; and
Species B: Represented by Figure 3.

However, as discussed herein, the restriction requirement (1) fails to indicate with respect to the claimed invention any characteristics of either Species A or Species B, and (2) fails to set forth any explanation as to how alleged Species A and B might be patentably distinct from one another. Accordingly, the restriction requirement fails to indicate how an election of alleged Species A might constitute a non-election of alleged Species B (or vice versa). Therefore, Applicants respectfully submit that the inadequacies of the restriction requirement are such that no meaningful election may be made. Regardless, Applicants hereby **elect alleged Species A with traverse** only insofar as such an election is required in order to be fully responsive to a restriction requirement per 37 C.F.R. §1.143. However, the Office Action fails to indicate how Applicants' election of alleged Species A constitutes a non-election of alleged Species B, as discussed above.

In the absence of the Office Action listing any claims which encompass alleged Species A, Applicants list pending claims 1-50 as encompassing the elected alleged Species A only insofar as a listing is also required in order to be fully responsive to a restriction requirement, per 37 C.F.R. §1.143. Regardless of the sufficiency or insufficiency of the restriction requirement, Applicants further submit that claims 1-50 are **generic** to any alleged Species A and/or B, at least insofar as each of claims 1-50 is directed to an invention which may be represented by either of Figure 2 or Figure 3, and none of claims 1-50 includes limitations which precludes their respective inventions from being represented by either Figure 2 or Figure 3. Applicants traverse the above restriction requirement for at least the following reasons.

Restriction not based on the invention "as claimed"

Applicants respectfully submit that the above restriction requirement is **improper** for at least the reasons set forth herein. First, in failing to include any listing of claims

which allegedly encompass either alleged Species A or alleged Species B, the Office Action fails to meet the basic requirements for restriction set forth in M.P.E.P. § 802. MPEP § 802 states that “[i]f two or more independent and distinct inventions **are claimed in one application**” restriction may be required (35 U.S.C. 121, *emphasis added*); “Two or more independent and distinct inventions may not be **claimed in one national application...**” (37 CFR 1.141, *emphasis added*); and “If two or more independent and distinct inventions are **claimed in a single application,**” the application may be restricted (37 CFR 1.142, *emphasis added*). Similarly, M.P.E.P. §808.02 states that restriction under 35 U.S.C. 121 is **never** proper where related inventions are not patentably distinct **as claimed**, where the inventions **as claimed** are **shown to be** independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06.

The Office Action does not attempt to make **any actual showing** that Applicants invention **as claimed** is directed to independent or distinct inventions. Although alleged Species A is purported to be represented by Figure 2, no explanation is provided as to what if any distinguishing features of Figure 2 define alleged Species A. Nor is any explanation provided as to what claims or claim limitations may be directed to such allegedly distinguishing features of Figure 2. Similarly, although alleged Species B is purported to be represented by Figure 3, no explanation is provided as to what if any distinguishing features of Figure 3 define alleged Species B. Nor is any explanation provided as to what claims or claim limitations are directed to such allegedly distinguishing features of Figure 3. Accordingly, alleged Species A and B are only indicated by general reference to two figures in the specification, and **without** any reference to the **claims themselves**.

While it has been generally asserted that the application contains claims directed to patentably distinct species, the Office Action provides **no specific** indication as to how the application includes multiple inventions which are patentably distinct **as claimed**. Similarly, the general assertion in the Office Action that no claims are generic is unsupported, at least insofar as the Office Action fails to set forth any distinguishing characteristics of the allegedly independent and distinct species. Therefore Applicant submits that there has been **no valid assertion** that more than one patentably distinct invention has been **claimed**.

Restriction fails to provide explanation for alleged “independent or distinct” claims

As indicated above, MPEP § 802 states that “[i]f two or more independent and distinct inventions are claimed in one application” restriction may be required (35 U.S.C. 121, **emphasis added**). With respect to alleged Species A and B, the Office Action merely provides an **unsupported** assertion that the species are independent **or** distinct because claims to the different species recite the mutually exclusive characteristics of the species. However, the Office Action fails to assert that the alleged Species A and B are independent **and** distinct, which is the appropriate standard for restriction under 35 U.S.C. 121. Furthermore, the assertion that claims to the different species recite mutually exclusive characteristics is unsupported at least insofar as the Office Action both (1) fails to set forth **any** characteristics of the alleged species, and (2) further fails to set forth which claims may be directed to said characteristics. Therefore, the Office Action fails to provide any **explanation** as to why, for example, any two of the pending claims are either independent or distinct or mutually exclusive.

As stated in M.P.E.P. § 808.01 (**emphasis added**):

“The **particular reasons relied on by the examiner** for holding that the inventions as claimed are either independent or distinct **should be concisely stated. A mere statement of conclusion is inadequate.** The **reasons** upon which the conclusion is based **should be given**....Each relationship of claimed inventions should be similarly treated and the **reasons for the conclusions** of distinctness or independence **set forth.**”

Furthermore, as stated in M.P.E.P. § 808.01(a) (**emphasis added**):

“Where there is a relationship disclosed between species, such **disclosed relation must be discussed and reasons advanced** leading to the conclusion that the disclosed relation does not prevent restriction, in order **to establish the propriety** of restriction.”

Furthermore, MPEP § 806.04(f) states that:

“Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. ... This may ... be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope.”

The Office Action fails to include (1) any concisely stated **reason** for concluding that any inventions **as claimed** are allegedly either independent or distinct, (2) any discussion why the relationship of features disclosed in FIG. 2 and FIG. 3 might not prevent restriction,

or (3) any explanation as to why FIG. 2 and FIG. 3 might not overlap in scope.

Therefore, Applicants respectfully submit that a proper restriction requirement has not been issued, based at least on the failure of the Office Action to explain any reasons as to why the claims might be independent and distinct claims.

Restriction fails to provide explanation for alleged "serious burden"

The Office Action generally alleges that there is an examination and search burden due to the allegedly mutually exclusive characteristics of the alleged species. However, as stated previously, the Office Action both (1) fails to set forth any characteristics of either of the alleged species, and (2) further fails to set forth which claims recite said characteristics. Accordingly, the Office Action has failed to show that there is a serious burden at least insofar as no allegedly mutually exclusive characteristics of the alleged species are identified in the Office Action.

Furthermore, any alleged reasons for the alleged examination and search burden are both (1) not clearly asserted, and (2) unsupported by the Office Action. Rather than actually identify a reason as to why there is an alleged examination and search burden, the Office Action states (emphasis added):

"The species require a different field of search...; and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph."

However, the above-cited passage merely provides a list of **possible** reasons, without identifying **which** of these possible reasons is an **actual** reason for the alleged examination and search burden. Regardless of which of the above possible reasons were intended to be offered as an actual reason for an alleged examination and search burden, the Office Action provides **no explanation** in support of **any** of the above-cited possible reasons actually resulting in the alleged examination and search burden.

As stated in M.P.E.P. § 808 (emphasis added):

"Every requirement to restrict has two aspects: (A) the **reasons (as distinguished from the mere statement of conclusion)** why each invention **as claimed** is either independent or distinct from the other(s); and (B) the **reasons** why there would be a **serious burden** on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections.

Furthermore, as stated in M.P.E.P. §803(II) state (emphasis added):

“Examiners **must provide reasons and/or examples to support conclusions**....For purposes of the initial requirement, a **serious burden** on the examiner may be *prima facie* shown by **appropriate explanation** of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing **may be rebutted** by appropriate showings or evidence by the applicant....”

Furthermore, as stated in M.P.E.P. §808.02 (emphasis added):

“Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP § 806.05).

Where the inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, **must explain why there would be a serious burden** on the examiner if restriction is not required. Thus the examiner **must show by appropriate explanation** one of the following:

- (A) Separate classification thereof:...
- (B) A separate status in the art when they are classifiable together:...
- (C) A different field of search: ...”

Applicants respectfully submit that the Office Action makes a mere statement of conclusion that there is an examination and search burden, without any appropriate identification or explanation of a particular reason for the alleged burden.

Contrary to the assertions of the Office Action, Applicants respectfully submit that there is **no such serious burden**, as evidenced at least by the searches and examination of the application which have **already taken place** without a need to impose a restriction requirement. Particularly illustrative of there being no serious burden on the Examiner is the fact that the Office Action relies merely on the specification – and **not** the actual claims – as the basis for asserting allegedly patentably distinct species A and B. However, this same specification has been the subject of examination for the Office Action of February 01, 2007, the Office Action of July 05, 2007, and the Advisory Action of September 10, 2007 – without any need to impose a restriction requirement. Furthermore, the previous Restriction Requirement of the Office Action mailed December 27, 2007 failed to recognize any such a burden, insofar as it failed to even identify a distinction between currently alleged Species A and currently alleged Species B.

Applicants respectfully submit that the absence of any previously-asserted restriction requirement in the course of earlier prosecution of this case is indicative of

there being **no serious burden** on the Examiner, and that an assertion of such a restriction requirement at this time contradicts the statement of M.P.E.P. §707.07(g) that **piecemeal examination** should be **avoided** as much as possible. Accordingly, the above restriction requirement of the Office Action is **improper**, and Applicants respectfully request that said restriction requirement be withdrawn.

Applicants' claims are directed to a single invention

Applicants respectfully submit that the claims are not directed to patentably distinct species for at least the following reasons. Firstly, MPEP § 806.04(e) states that: "Species always refer to the different embodiments of the invention." However, Applicants note that the use of phrases such as "according to an embodiment of the invention" (page 5, para. [0007]), or "[i]n an embodiment" (page 8, para. [00014]) in reference to disclosed features in Applicant's application **do not restrict** each disclosed feature to a different embodiment. Rather, as stated on page 20, para. [00045] of the specification (emphasis added):

'It should be appreciated that reference throughout this specification to "one embodiment" or "an embodiment" means that a particular feature, structure or characteristic described in connection with the embodiment is included in at least one embodiment of the present invention. Therefore, **it is emphasized** and should be appreciated that two or more references to "an embodiment" or "one embodiment" or "an alternative embodiment" in various portions of this specification are **not necessarily** all referring to the same embodiment. Furthermore, the particular features, structures or characteristics **may be combined as suitable in one or more embodiments** of the invention.'

Accordingly, "[e]mbodiments of the invention are illustrated by way of example, and not by way of limitation" (page 4, para. [0005]).

Therefore Applicant respectfully submits that the various figures and passages of the specification which are alleged to describe patently distinct species are merely **illustrative** of particular features, structures or characteristics which, although they may be combined as suitable in one or more embodiments of the invention, are not themselves restricted to "different embodiments" or species.

As stated in paragraph [00023] of the specification, FIG. 2 is a block diagram of **selected elements** of distributed system 200, where some of said elements are similar to (or the same as) corresponding elements shown in FIG. 1. Similarly, as stated in

paragraph [00025] of the specification, FIG. 3 is a block diagram of **selected elements** of distributed system 300, where some of said elements are similar to (or the same as) corresponding elements shown in the same FIG. 1. Accordingly, FIG. 2 and FIG. 3 may **overlap**, and are therefore **not mutually exclusive**, at least insofar as they **both** include elements corresponding to elements of FIG. 1. Furthermore, as indicated above, each of claims 1-50 is directed to an invention which may be represented by either of Figure 2 or Figure 3, and none of claims 1-50 includes limitations which precludes their respective inventions from being represented by either Figure 2 or Figure 3. Therefore, alleged Species A overlaps any claims which may be purported to encompass alleged species B, meaning that the two alleged Species A and B cannot therefore be mutually exclusive species.

Reliance on M.P.E.P. §818.03(b), paragraph ¶8.22

The Office Action (page 3, item 8) includes language taken from a form paragraph ¶8.22 of M.P.E.P. §818.03(b), which states that the reply “to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) **identification of the claims** encompassing the elected invention” (emphasis added). The Office Action seems to interpret this particular phrasing of form paragraph ¶8.22 as meaning that the restriction requirement itself need not identify which claims encompass an alleged group or species, and that an applicant can be assigned the burden of determining which claims encompass an alleged group or species.

Applicants respectfully submit that such an interpretation is contrary at least to the above-cited requirements for issuing a restriction as set forth in M.P.E.P. § 802, M.P.E.P. §808.01, M.P.E.P. §808.02, M.P.E.P. §803(II), M.P.E.P. § 808, etc. In light of said requirements, it is Applicants understanding that form paragraph ¶8.22 merely sets forth a clerical requirement that, for the convenience of an examiner and/or in order to avoid ambiguity in the record, a reply must specifically recite those claims which the restriction requirement has already identified as encompassing the elected species or group. However, it remains the burden of an examiner issuing a restriction requirement to articulate:

- (1) how two or more independent and distinct inventions are **claimed in one application**,
- (2) the reasons (as distinguished from a mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s), and
- (3) the **reasons** why there would be a **serious burden** on the examiner if restriction is not required.

It is unreasonable to interpret the particular phrasing of one sentence in one form paragraph ¶8.22 as vitiating all of the above-cited requirements for issuing a restriction, and shifting the burdens of said requirements to the applicant. For at least the foregoing reasons, Applicants respectfully submit that the above restriction requirement is improper.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the restriction requirement of the Office Action has been overcome. Applicants also assert that, for at least the reasons set forth in Applicants communication of August 30, 2007, claims 1-50 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
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